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Attorney Docket No. 113708.130US1

REMARKS

Applicant notes with appreciation receipt of an initialed copy of the form PTO-1449 filed on May 29, 2007.

Claims 1-13, 15, 16, 18-25, 27-33, 35-41, and 43-45 are pending. Claims 14, 17, 26, 34, and 42 are canceled. Applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1-13, 15, 18-25, 27-33, 35-41, and 43-45 were rejected under 35 USC 112, second paragraph, as being indefinite. Particularly, the rejection objects to the limitation "can be" and "can have" appearing in claims 1, 22, 30 and 38, and asserts that these phrases "mean a possibility an action may perform not certain."

These claims are rejected due primarily to an alleged lack of clarity. There is no *per se* restriction against use of the term "can" in a claim. To the contrary, a rejection under section 112, second paragraph requires that A) claims set forth subject matter applicants regards as the invention; and B) claims particularly point out and distinctly claim the subject matter of the invention. Since A) relies on subjective interpretation, B) necessarily forms the objective basis for a rejection under this paragraph. Item B) requires an inquiry into the definiteness of the claim, e.g. whether the scope of the claim would be clear to a person of ordinary skill in the art (MPEP 2171).

Applicant submits that the claims would have been clear and unambiguous to one of ordinary skill in the art as written. Consider, for example, the phrase "selecting a plurality of attributes to be associated with the at least one document, wherein the selected attributes can be any of the plurality of attributes." Since the phrase "can be any of" refers to common logical usage for determining what something can be (as distinguished from what it cannot be), the

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claim would be clearly understandable to one of ordinary skill as referring to what a selected attribute can be. The rejection asserts that the term "can" means that an action is uncertain; to the contrary, the action of "selecting" is not optional.

In regard to the phrase "the attribute types are ordered in a tree-structure hierarchy and an attribute type can have parent and child attribute types," the rejection treats this phrase as being indefinite because "a possibility an action may perform not certain." Again, the rejection does not explain why one of ordinary skill in the art would not understand this very precise language referring to a tree-structure, even through this limitation has been understood, as demonstrated by the newly cited "Morgenstern" reference.

Thus the rejection is improper under 35 U.S.C. §112 second paragraph. Nevertheless, in order to expedite prosecution, the wording has been revised to avoid use of the term "can."

Claims 1-13, 15, 16, 18-25, 27-33, 35-41, and 43-45 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent Pub. No. 2002/0011636, Grainger ("Grainger") in view of U.S. Patent No. 5,970,490, Morgenstern ("Morgenstern"). Insofar as the rejection may be applied to the claims as amended, applicant respectfully traverses the rejection for reasons including the following, which are provided by way of example.

The application recognizes that personnel may wish to "label attributes of various intellectual properties and related documents of a company, its partners, and/or competitors, and/or to manage the attributes, to utilize attributes in filtering intellectual property documents." (Page 4, lines 9-12.) Independent claim 1 recites in combination, for example, "(A) providing a group of a plurality of documents including at least one document; (B) selecting a plurality of attributes to be associated with the at least one document, wherein the selected attributes are any of the plurality of attributes; and (C) for each of the selected attributes, automatically tagging ...

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the documents in the group ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute; and storing ... respective references in association with each selected attribute and the ancestor attributes, ...” (See also independent claims 22, 30 and 38.) Thereby, the method and system can provide that “all of the attributes that otherwise would have been selected in a step-by-step manner may be assigned simultaneously and automatically by tagging the intellectual property document or file with not only the selected attribute(s), but all of the other attributes that are at a level higher than the selected attributes.” (E.g., specification page 58, lines 1-5.)

On the other hand, without conceding that Grainger discloses any feature of the present invention, Grainger is directed to managing documents related to a patent application. A Case Data Unit can store bibliographic information (case meta data) associated with a patent case, and electronic documents related to the patent case. Each document in a Case Data Unit includes document meta data to identify the document; the document and the document meta data are referred to as a Document Entity. (Paragraphs [0057], [0058], [0059].) When a Document Entity is created within the context of a Case Data Unit, the Document Entity can acquire some of its attributes from that Case Data Unit. (Paragraph [0067].)

Morgenstern is directed to a method for processing heterogeneous data to drive program generation of information mediators, inclusion of structure file formats, development of a uniform data description language, and use of annotations to separate out the heterogeneity that heretofore led to special purpose interfaces. (Abstract.)

To properly reject a claimed invention, a *prima facie* case of obviousness must be established. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the reference (or references when

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combined). *In re. Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, it is necessary to identify the reason why a person of ordinary skill in the art would have combined allegedly known elements in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.* 550 U.S. ___, 82 U.S.P.Q.2d 1385 (2007). The PTO bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). Where, as here, a *prima facie* case of obviousness has not been established, then without more applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

Applicant provides herein a selection of some examples of limitations in the claims which are neither taught nor suggested by Grainger. The Office action admits that Grainger "does not explicitly disclose the claimed 'the attribute types are ordered in a tree-structure hierarchy.'" (Office action, page 4.) Recognizing that Grainger fails to teach and/or suggest the invention as claimed, Morgenstern is cited to remedy the deficiencies as allegedly focusing on hierarchical tree-structures as a dominant structuring mechanism. Nevertheless, Morgenstern fails to remedy such deficiencies.

First, the rejection asserts that Grainger's document that "has one or more attributes associated therewith" teaches "automatically tagging the document with the ancestors in the hierarchy of each of plural attributes but not descendants or siblings in the hierarchy of each selected attribute." To the contrary, Grainger is admitted in the Office action as not teaching or suggesting ancestors, descendants and siblings. Grainger cannot teach or suggest the automatic tagging, as recited. Morgenstern does not remedy these deficiencies. Accordingly, no *prima facie* case of obviousness has been established.

Second, the Office action failed to consider the limitation "automatically tagging ... the documents in the group ... with each selected attribute and with all attributes of all ancestors but

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not descendants or siblings in the hierarchy of each selected attribute" (underlined to point out the limitation which was not considered.) There simply is no consideration of this limitation in the Office action. The Office action appears to mis-quote the claims, and it appears that the claims have been mis-read. Accordingly, no *prima facie* case of obviousness has been established.

Third, Grainger fails to teach or suggest "selecting a plurality of attributes" and "for each of the selected attributes, automatically tagging, in the first data storage, the documents ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute; ..." The Office action contends that this feature is inherent in Grainger, citing Grainger paragraph [0016] as being particularly relevant. According to Grainger paragraph [0016], "each of the plurality of electronic documents has one or more attributes associated therewith and storing a rule in the database that determines specific electronic documents to be deleted from the database..." Hence, according to Grainger, associating an electronic document with plural attributes does not include "automatically tagging ... the documents in the group ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute." To the contrary, Grainger does not teach tagging with attributes of all ancestors in the hierarchy of the selected attribute.

Fourth, it is not understood how the rejection can consider Grainger's one or more attributes associated with an electronic document necessarily¹ to teach "automatically tagging, in

¹ That something may occur or be present in the prior art, which applicants vigorously deny, is insufficient to establish inherency. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). In order to support a contention of inherency, the allegedly inherent characteristic must necessarily flow from the teachings of the reference. *In re Levy*, 17 USPQ2d 1461, 1464 (Bd Pat. App. & Inter. 1990). Accordingly, the Examiner is respectfully requested to

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the first data storage, the documents ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute." The cited portion of Grainger states that each of the electronic documents has one or more attributes associated therewith. However, the claims recite "selecting a plurality of attributes" and "for each of the selected attributes, automatically tagging, in the first data storage, the documents ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute; ..." Claims can only be given their "broadest reasonable interpretation." *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." 710 F.2d at 802, 218 USPQ at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original). It is completely unreasonable for the rejection to ignore this claim limitation of "automatically tagging ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute." In any event, the Office action already admits that Grainger fails to teach the hierarchy. Hence, it is not understood how Grainger can or is to make use of a hierarchy that is non-existent in its structure. Consequently, Grainger fails to teach or suggest the combination of selecting a plurality of attributes" and "for each of the selected attributes, automatically tagging, in the first data storage, the documents ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute; ...".

Fifth, Grainger teaches away from tagging with all attributes of the ancestors in the hierarchy. Specifically, Grainger teaches that "users not assigned to the group will not have

provide a citation to a reference or an Examiner's affidavit that tagging necessarily includes attributes of ancestors but not descendants or siblings in the hierarchy, or to withdraw the rejection. 37 CFR 1.104(d)(2); MPEP 2144.03.

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access to Case Data Units in that group" (paragraph [0061]). Hence, Grainger specifically teaches away from automatically tagging a Case Data Unit with additional groups (i.e. ancestors in the hierarchy), because to do otherwise would allow users access to Case Data Units in other groups. Therefore, not only does Grainger not teach automatically tagging with attributes of all ancestors in the hierarchy of each selected attribute, to modify Grainger to do so would destroy a purpose of Grainger.

Sixth, according to Grainger, "when a Document Entity is created within the context of a Case Data Unit, the Document Entity acquires some of its attributes from that Case Data Unit. For example, an amendment created for a particular patent application will automatically acquire some attributes of that patent application such as technology developer reference number, practitioner reference number, etc." ([Paragraph [0067]). According to Grainger, the Document Entity acquires only some, but not all, of the attributes of the Case Data Unit. Thus, Grainger fails to teach or suggest that the documents are automatically tagged with all attributes of all ancestors in the hierarchy of each selected attribute. Indeed, if Grainger is interpreted as the rejection contends, at least one express purpose of Grainger is destroyed.

Finally, the Office action now cites Morgenstern as teaching hierarchical tree structures to remedy Grainger's flat structure of a Case Data Unit containing a Document Entity, where it is not possible for an attribute to have both parent and child attributes. Nevertheless, even if Morgenstern and Grainger are combined, the combined teachings still fail to teach or suggest the combination of "(B) selecting a plurality of attributes to be associated with the at least one document ...; and (C) for each of the selected attributes, automatically tagging ... the documents in the group including the at least one document, with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute..." The Office action argues, for example, that three different kinds of aggregations

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listed in Morgenstern, col. 9, lines 60-68, teach or suggest selecting a plurality of attributes, and for each of the selected attributes, automatically tagging the documents as recited. However, Morgenstern's aggregating attribute fields for a record, aggregating an objects attributes and methods, or aggregating set-valued attributes fails to teach or suggest selecting a plurality of attributes and for each of the selected attributes, automatically tagging the documents as recited. The rejection also cites Morgenstern col. 43, lines 7-20 as teaching attributes ordered in a tree-structure hierarchy. However, use of Morgenstern's single attribute path fails to teach or suggest selecting a plurality of attributes and for each of the selected attributes, automatically tagging the documents as recited. The Office action also cites the logical structure diagram with hyperedges of Morgenstern col. 12, lines 56-64, as teaching attributes ordered in a tree-structure hierarchy. However, a logical structure diagram, even annotated and including hyperedges, fails to teach or suggest selecting a plurality of attributes and for each of the selected attributes, automatically tagging the documents as recited.

Hence, Grainger and Morgenstern, alone or in combination, fail to teach or suggest the combination of features recited in independent claims 1, 22, 30 and 38. In addition, Grainger and Morgenstern clearly fail to show other recited elements as well.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 22, 30 and 38, but also because of additional features they recite in combination.

Furthermore, it is noted that the Office action fails to attempt to make a complete *prima facie* of obviousness for various dependent claims. These are outlined below. Each of these arguments was previously presented but has not been considered in the latest Office action.

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It is noted that the office action has typographical errors in its numbering of dependent claims 4 and 5, as noted for the second time.

Claim 15 recites that "the attributes are selected from a plurality of attribute types representative of at least one of: a product and a service." The Office action argues that Grainger discloses a plurality of attribute types, and cites Grainger paragraphs [0134] and [0016]. The Office action is devoid of any indication where Grainger teaches attribute types representative of product or service. In any event, Grainger fails to teach or suggest attribute types representative of product or service. Accordingly, claim 15 is allowable over the reference.

Claims 25, 33, and 41 also include the same recitation as claim 15. The rejections of claims 25, 33 and 41 in the Office action merely refer back to the rejection of claim 15. Accordingly, claims 25, 33 and 41 are allowable over the references.

Claim 18 additionally recites "the step of exporting the tree structure hierarchy including the attributes and the attribute types." The Office action argues that Grainger paragraph [0016] discloses a plurality of attribute types, and that Grainger paragraph [0134] teaches attribute types associated with document entities. These citations are completely irrelevant and unrelated to the entirety of claim 18. The Office action is devoid of any attempt to argue that Grainger teaches exporting any data structure, let alone a tree structure hierarchy. In any event, Grainger does not teach or suggest exporting the tree structure hierarchy including attributes and attribute types. Therefore, claim 18 is allowable over the references.

Claim 20 depends from dependent claim 19. Claim 19 recites "further comprising utilizing the attributes as criteria for at least one of searching, retrieving, reporting and viewing the at least one document." Claim 20 then recites that "the attributes can be utilized in combination with: (i) at least one of the attribute types, (ii) at least one sub-type of the at least

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one attribute type, (iii) a content of at least one field in the at least one document; (iv) a type of at least one field in the at least one document; and (vi) information derived from the at least one field in the at least one document.” The rejection appears to have mistaken the word “and” in claim 20 for the word “or”, and has considered only element (i) recited in claim 20: the Office action merely states with regard to claim 20 that “Grainger discloses ‘an attribute type’ (type attribute associated with document Entities, [0134]).” There is no attempt to show where Grainger teaches elements (ii) – (vi). Because the Office action fails to even attempt to show where Grainger teaches five of the elements recited in claim 20, applicant respectfully submits that the rejection of claim 20 must be withdrawn.

Claims 28, 36 and 44 include the same recitations as claim 20. The rejections of claims 28, 36 and 44 in the Office action merely refer back to the rejection of claim 20. Accordingly, claims 28, 36 and 44 are allowable over the references.

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

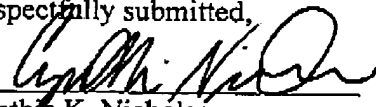
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In view of the foregoing, applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,


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